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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,530	01/28/2000	Duane J. Pontbriand	60.158-107	2373

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

13

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/493,530

Examiner

Sandra M. Nolan

Applicant(s)

PONTBRIAND ET AL.

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Janaury 22, 2002 (mailed October 22, 200).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Finality Withdrawn/Prosecution Reopened***

1. The finality of the Office Action mailed on May 11, 2001 (Paper No. 7) is withdrawn and prosecution is reopened in order to apply the new grounds of rejection set forth hereinbelow.

### ***Rejections Withdrawn***

2. The 35 USC 103 rejection of claims 1, 4-8 and 10-12 as unpatentable over Anderson et al (US 5,082,698) in view of the Crea Nova bulletin, as recited in section 12 of the October 23, 2000 Office Action (Paper No. 4) and repeated in section 3 of the August 3, 2001 Office Action (Paper No. 9), is withdrawn in view of the arguments in the brief filed on January 22, 2002 (mailed October 22, 2001; Paper No. 12).

3. The 35 USC 103 rejection of claim 2 as unpatentable over Anderson in view of Crea Nova taken with Sakakibara et al (US 4,268,542), as recited in section 13 of Paper No. 4 and repeated in section 4 of Paper No. 9, is withdrawn in view of the arguments in Paper No. 12.

### ***New Rejections***

#### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 8 recites the limitation "said outer epoxy coating plastic particles" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 2, 4-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al (US 5,178,902) in view of Tanaka et al (US 5,993,975).

Wong teaches the coating of steel pipes (col. 1, line 16) with protective composite coatings (abstract, line 2).

Wong fails to teach the specific coatings or the pretreatment step recited in applicants' claims.

Tanaka teaches the coating of steel plates with zinc coatings (col. 7, lines 8-10 and 44+). The coated steel is later dip-coated (col. 7, line 53) with a coating composition containing 2 to 40% (col. 6, lines 11-15) of nylon-12 particles (col. 5, line 40) that are of

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0.2 to 80 um in size (col. 5, line 33) and an epoxy-modified polyester resin (col. 2, line 36). The Tanaka coatings provide corrosion resistance, impact resistance and scratch resistance (abstract, lines 4-5).

Both patents deal with the treatment of ferrous substrates with protective coatings.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the coatings of Tanaka in order to render the steel pipes of Wong resistant to corrosion, impact and scratching.

The motivation to employ the coatings of Tanaka to render the steel pipes of Wong resistant to corrosion, impact and scratching is found in the abstract of Tanaka where the use of Tanaka's coatings to render steel surfaces more corrosion resistant, impact resistant and scratch resistant is taught. It is deemed desirable to make Wong's steel pipes more corrosion resistant, impact resistant and scratch resistant in order to improve their useful lives.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 2, 4-8 and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

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If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.

*SMN*

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09493530(13)  
April 3, 2002

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*4/4/02*